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JOHN MAGE
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TERRY GROSS

December 14, 1994

BY EXPRESS MAIL, Label No. HB309359061

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513


Re: Cancellation No. 22,881

Dear Sir/Madam:

Enclosed please find for filing the original and a copy of respondent's Response To Request For Extension Of Time In which To Respond To Motion For Summary Judgment in the above-referenced cancellation proceeding. A Certificate of Express Mailing and Service is appended to the end of the document.

Thank you for your attention.

Sincerely yours,


Caroline Rule

cc: Robert B. Kennedy, Esq.
Kennedy & Kennedy
400 Northpark Town Center
1000 Abernathy Road
Atlanta, Georgia 3032

TTAB
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Jose Ma. Arechabala Rodrigo)

Cancellation No. 22,881

v.)

Havana Rum and Liquors, S.A.)
DBA H.R.L., S.A.)

Registration No. 1,031,651)

**RESPONSE TO REQUEST FOR EXTENSION OF TIME IN WHICH TO
RESPOND TO MOTION FOR SUMMARY JUDGMENT**

Respondent¹ respectfully submits this response to petitioner's request for an extension of time in which to respond to the motion for summary judgment in the above-captioned matter, in order to respond to petitioner's arguments and to correct certain inaccuracies in petitioner's submission.

First, petitioner asserts that he submitted a response in opposition to respondent's Motion For Extension Of Time To File Answer To Petition For Cancellation. Respondent's counsel, however, did not at any time receive a copy of such opposition papers. (Rule Aff. ¶ 4 Krinsky Aff. 4.) Respondent is thus unable to comment on any arguments made by petitioner

¹ The word "respondent" will be used throughout this document to refer collectively and separately to Havana Rum & Liquors, S.A. and Havana Club Holding, S.A.

therein. If counsel for petitioner failed to serve the opposition papers on respondent's counsel, those papers should be disregarded. If the opposition papers failed to reach respondent's counsel through no fault of petitioner, respondent should nevertheless be furnished with a copy of those papers now, and permitted to reply if necessary.

Petitioner asserts that he argued in those papers that the extension of time in which to answer requested by respondent was excessive. As set forth in respondent's Motion For Extension Of Time To File Answer To Petition For Cancellation, however, the requested extension of time was necessary in order to permit respondent's attorneys to communicate with parties in Cuba, where both Havana Rum & Liquors, S.A., the original respondent named by the Trademark Office in this action, and Havana Club International, S.A., the current licensee of the trademark, are located. As was explained in the Affidavit of Caroline Rule, Esq. submitted in support of that motion, there was no telephone service between the United States and Cuba, and consequently no fax service. Moreover, there is no mail service between the United States and Cuba. As a result, communication between respondent and its counsel in New York is time-consuming and difficult. The additional time requested under these unusual circumstances, therefore, was reasonable, particularly in light of the fact that, as was likewise set forth in the affidavit of Caroline Rule, respondent's attorneys only received the notice of this petition for cancellation twenty-four days before the answer was due.

The requested extension of time in which to answer was therefore necessary in order to allow respondent's attorneys to research the dense factual background underlying respondent's defenses -- facts that respondent's attorneys could ascertain only through cumbersome communications with parties in Cuba. The seventeen-page Answer itself illustrates

that this lengthy factual research was necessary in order fully to respond to the petition for cancellation and to assert respondent's counterclaims.

Second, petitioner apparently suggests that respondent's Motion For Joinder And Substitution Of Party Respondent presents a difficult issue for this Board's consideration, and insinuates that the filing of this motion was somehow inappropriate, stating inaccurately: "On October 27, 1994 without Respondent having yet filed its Answer, it moved to join Havana Club Holding, S.A. in this proceeding and later, after the recording of an assignment, to have it substituted as respondent." (Request For Extension Of Time In Which To Respond To Motion For Summary Judgment at p. 2.) Respondent's motion was, in fact, filed simultaneously with the Answer. And, despite petitioner's accusatory tone, this motion represents a perfectly reasonable approach to a situation in which ownership of the registration at issue in this proceeding had been assigned after this cancellation proceeding was commenced. Indeed, respondent's counsel made this motion only after consulting with an attorney at the Trademark Trial and Appeals Board concerning the appropriate method of dealing with this situation. (See Rule Aff. ¶¶ 6, 7.)

The facts that necessitated the Motion For Joinder And Substitution Of Party Respondent were set forth in the motion itself. The United States registration of the trademark Havana Club was assigned from Cubaexport (the party that petitioner originally named as respondent) to Havana Rum & Liquors, S.A. on January 10, 1994, and this assignment was recorded in the Patent and Trademark Office on February 10, 1994. As a result of this assignment, the Patent and Trademark Office itself correctly substituted Havana Rum & Liquors, S.A. for Cubaexport as the respondent.

The registration of the Havana Club trademark was subsequently assigned from Havana Rum & Liquors, S.A. to Havana Club Holding, S.A. on June 22, 1994. The assignment was mailed to the Patent and Trademark Office for recording on September 7, 1994. (Affidavit of Caroline Rule, Esq. in support of Motion For Joinder And Substitution Of Party Respondent at ¶ 4.) When respondent filed its Answer to the petition on October 27, 1994, however, that assignment had not yet been recorded by the Patent and Trademark Office. (Notice Of Motion For Joinder And Substitution Of Party Respondent at p. 2; Declaration of Caroline Rule in support of Motion For Summary Judgment at ¶ 3.) Petitioner is simply wrong when he asserts that "such recordation was effected on September 7, 1994, according to the the declaration of Luis Francisco Perdomo Hernandez, in an exhibit to the respondent's own Motion for Summary Judgment." (Request For Extension Of Time In Which To Respond To Motion For Summary Judgment at p. 2.) The declaration in question in fact states only that "this assignment was presented to the Trademark Office for recording on September 7, 1994." (Perdomo Decl. ¶ 5.) That statement is perfectly accurate -- the assignment was mailed to the Trademark Office on that date -- but the assignment had not yet been recorded by the Trademark Office as of October 27, when respondent filed its Answer. Petitioner is simply trying to manufacture inconsistencies and controversies where none exists.

An attorney at the Trademark Trial and Appeals Board advised respondent's counsel that the name of the current owner/assignee of the registration should appear on the Answer. (Rule Aff. ¶ 5.) Thus, the Answer was submitted on behalf of both Havana Rum & Liquors, S.A., the party then appearing in the records of the Patent and Trademark Office as the owner of the registration, and Havana Club Holding, S.A., the current owner of the registration.

Because the assignment to Havana Club Holding, S.A. had not yet been recorded when respondent filed its Answer, respondent did not simply move at that time to have Havana Club Holding, S.A. substituted as the respondent in this case, but rather moved to have Havana Club Holding joined as an additional party respondent until such time as the assignment was recorded, and then to have Havana Club Holding substituted as respondent.

The assignment was in fact recorded subsequent to the filing of the Answer in this case, and was then recorded retroactively to the date the assignment papers were received in the Patent and Trademark Office, September 13, 1994. That recordation can be found at Reel 1219, Frame 0428. (Declaration of Caroline Rule in support of Motion For Summary Judgment at ¶ 3.) Thus, the status of Havana Club Holding, S.A. as current owner of the registration of the Havana Club trademark now appears in the records of the Patent and Trademark Office. Havana Club Holding, S.A. should therefore now simply be substituted as party respondent in this case.

Because the Motion For Substitution And Joinder Of Party Respondent had not yet been decided when respondent submitted its Motion For Summary Judgment, however, that latter motion was also submitted in the name of both Havana Rum & Liquors, S.A. and Havana Club Holding, S.A.

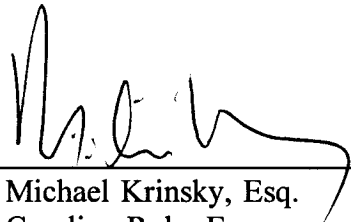
Finally, respondent does not object to petitioner's request for an extension of time in which to respond to the Motion For Summary Judgment *per se*, but does object to the open-ended request for an extension until thirty days after the above-discussed motions are decided.

Petitioner should simply be permitted an additional definite period of time in which to answer this motion.

Dated: New York, New York
December 14, 1994

Respectfully submitted,

RABINOWITZ, BOUDIN, STANDARD,
KRINSKY & LIEBERMAN, P.C.

By: 
Michael Krinsky, Esq.
Caroline Rule, Esq.

Attorneys for Havana Club Holding, S.A.
and Havana Rum & Liquors, S.A.
740 Broadway - Fifth Floor
New York, New York 10003
(212) 254-1111

To: Robert B. Kennedy, Esq.
Kennedy & Kennedy
400 Northpark Town Center
1000 Abernathy Road, Suite 1250
Atlanta, GA 30328

Jose Ma. Arechabala Rodrigo)	Cancellation No. 22,881
)	
v.)	
)	AFFIDAVIT OF
Havana Rum and Liquors, S.A.)	<u>CAROLINE RULE, ESQ.</u>
DBA H.R.L., S.A.)	
)	
Registration No. 1,031,651)	
)	

CAROLINE RULE, ESQ., being duly sworn, deposed and says:

2. I make this affidavit in support of respondent's Response To Request For Extension Of Time In Which To Respond To Motion For Summary Judgment.

1/ The word "responent" is used throughout this affidavit to refer collectively and separately to Havana Rum & Liquors, S.A. and Havana Club Holding, S.A.

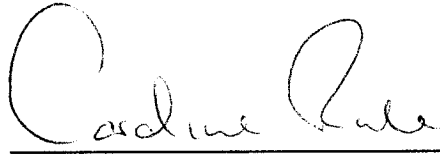
3. I make this affidavit upon personal knowledge, and upon information and belief based on my review of the file in this case.

4. I did not receive any copy of a response by petitioner to respondent's Notice Of Motion For Extension Of Time To File Answer To Petition For Cancellation, and I have never seen such response papers.

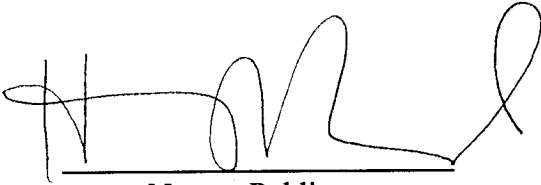
5. The notice of the petition for cancellation in this case, prepared by the Trademark Office, named Havana Rum & Liquors, S.A. as respondent. At the time that notice issued, Havana Rum & Liquors, S.A. appeared in the official records of the Trademark Office as the registrant of the trademark at issue in this case, Havana Club. On June 22, 1994, however, the ownership of that trademark was assigned to Havana Club Holding, S.A. The assignment was mailed to the Trademark Office for recording on September 7, 1994, and has since been recorded. At the time the answer was filed on October 27, 1994, however, that assignment had not yet been recorded, and Havana Rum & Liquors, S.A. was still listed in the records of the Trademark Office as the owner of the Havana Club trademark.

6. On or around October 24, 1994, I called the Trademark Trial and Appeals Board, and spoke with an attorney there in reference to this matter. I explained that I was about to file an answer to a petition for cancellation, and that the ownership of the registration of the subject trademark had been assigned subsequent to the filing of the petition for cancellation, but that the assignment had not yet been recorded. I asked in whose name the answer should be filed. That attorney advised me that the name of the current owner/assignee of the trademark should appear on the answer. That attorney also suggested that I should file a motion to join or substitute that current owner/assignee as party respondent.

7. After I received this advice, Michael Krinsky and I determined that, as the assignment from Havana Rum & Liquors, S.A. to Havana Club Holding, S.A. had not yet been recorded, and because Havana Club Holding, S.A. had not yet been substituted as respondent, the Answer should be submitted in the names of both Havana Rum & Liquors, S.A., the assignor of the trademark (which at that time still appeared in the official records as the owner of the trademark) and Havana Club Holding, S.A., the assignee of the trademark. We also decided that the Motion for Joinder and Substitution Of Party Respondent should request that Havana Club Holding, S.A. be joined as a respondent until such time as the assignment was officially recorded, and thereafter substituted as the respondent. These measures appeared to be the best way of ensuring that the rights of all parties were preserved until the current owner of the trademark registration, Havana Club Holding, S.A., was officially substituted as the respondent.


Caroline Rule, Esq.

Sworn to before me this
14th day of December, 1994


Notary Public

HILLARY RICHARD
NOTARY PUBLIC, State of New York
No. 24-5007355
Qualified in Kings County
Commission Expires January 25, 1995

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Jose Ma. Arechabala Rodrigo)

v.)

Havana Rum and Liquors, S.A.)
DBA H.R.L., S.A.)

Registration No. 1,031,651)
_____)

Cancellation No. 22,881

AFFIDAVIT OF
MICHAEL KRINSKY, ESQ.

STATE OF NEW YORK)
) ss.:
COUNTY OF NEW YORK)

MICHAEL KRINSKY, ESQ., being duly sworn, deposed and says:


1. I am a member of the bar of the State of New York and of the firm Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., attorneys for the respondent^{1/} in the above-captioned cancellation proceeding.

2. I make this affidavit in support of respondent's Response To Request For Extension Of Time In Which To Respond To Motion For Summary Judgment.

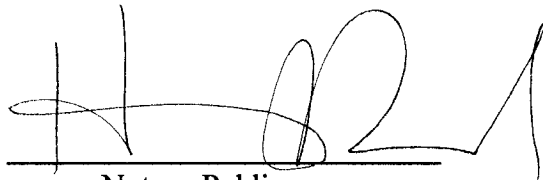
3. I make this affidavit upon my personal knowledge.

^{1/} The word "respondent" is used throughout this affidavit to refer collectively and separately to Havana Rum & Liquors, S.A. and Havana Club Holding, S.A.

4. I did not at any time receive a copy of a response by petitioner to respondent's Notice Of Motion For Extension Of Time to File Answer to Petition For Cancellation, and have not seen such response papers.


Michael Krinsky

Sworn to before me this
14th day of December, 1994


Notary Public

HILLARY RICHARD
NOTARY PUBLIC, State of New York
No. 24-5007355
Qualified in Kings County
Commission Expires January 25, 1995

Jose Ma. Arechabala Rodrigo

V.

Registration No. 1,031,651

Cancellation No. 22,881

I, Caroline Rule, Esq., hereby certify that the attached Respondent's Response To Request For Extension Of Time In Which To Respond To Motion For Summary Judgment in the above-captioned cancellation proceeding is being deposited today, December , 1994, with the United States Postal Service, utilizing the "Express Mail Post Office to Addressee" service, in an envelope addressed to to the following:

- 1) mailing label No. HB309359061, addressed to:

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

- 2) mailing label No. HB309359072, addressed to attorney for petitioner:

Robert B. Kennedy
Kennedy & Kennedy
400 Northpark Town Center
1000 Abernathy Road, Suite 1250
Atlanta, Georgia 30328

Signed this 14th day of December, 1994

Caroline Kuhl

Caroline Rule, Esq.